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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/537,812	03/28/2000	Russell W. White	111111.1111	4698

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EXAMINER
PEREZ GUTIERREZ, RAFAEL

ART UNIT	PAPER NUMBER
2686	12

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/537,812	White et al.	
	Examiner	Art Unit	
	Rafael Perez-Gutierrez	2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 February 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4-11,13-16,18-21,23 and 26-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4-11,13-16,18-21,23 and 26-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 March 2000* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Action is in response to the telephone interview of June 13, 2003 between SPE William G. Trost IV and Russell W. White. As result of said interview, the Final Office Action mailed on April 30, 2003 has been withdrawn. Applicant's amendments filed on September 19, 2002; December 2, 2002; and February 18, 2003 have been properly entered in the application. **Claims 1, 4-11, 13-16, 18-21, 23, 26-39** are now pending in the present application. **This Action is made NON-FINAL.**

Drawings

2. The drawings are objected to under 37 CFR 1.83(a) because **figure 1** fails to show **storage device 105** as described in the specification on **page 10 lines 23 and 24**. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d).

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference number mentioned in the description on **page 31 line 30**: On **figure 6**, reference number **607** identifying the tower is not shown in figure 6.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference numbers not mentioned in the description: On **figure 8**, reference

numbers **812, 813, and 814** are not mentioned in the description.

5. Applicant is required to submit a proposed drawing correction in reply to this Office Action. However, formal correction of the noted defect may be deferred until after the Examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the **ABANDONMENT** of the application.

Claim Objections

6. **Claim 19** is objected to because of the following informality: On **line 2** of **claim 19**, replace "low power" with --short-range-- before "RF" in order to provide proper antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claim 14 depends upon canceled **claim 12**, therefore, it is considered indefinite. For

purposes of applying prior art, **claim 14** is being examined as being dependent on **claim 11**.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

> A person shall be entitled to a patent unless -- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, 8-10, 16, 18-20, 23, 26-29, and 31-39 are rejected under 35 U.S.C. 102(e) as being anticipated by **Treyz et al. (U.S. Patent # 6,587,835 B1)**, newly cited.

Consider **claims 1, 26-29**, Treyz et al. clearly show and disclose a system 998 (figure 107) for communicating selected information to a handheld computing (electronic) device 12 (wireless telephone operable to communicate with a short-range wireless communication network) (figure 107 and column 9 line 57 - column 10 line 3, column 13 lines 23-38, column 15 lines 29-35 and 49-53, column 60 lines 59-62, column 61 lines 18-24, and column 62 lines 7-15 and 43-47), the system 998 comprising:

an audio kiosk 1000 (digital engine) (figure 107) operable to maintain data associated with selectable audio information, the audio information comprising an audio file (e.g., an MP3 file) or streaming audio information (e.g., when the user samples the audio) (column 60 lines 57-64, column 61 lines 25-30, and column 61 line 66 - column 62 line 4);

wireless communications circuitry 1014 (communication engine) (figure 107) communicatively coupled to the audio kiosk 1000 (digital engine), the wireless communications circuitry 1014 (communication engine) operable to initiate wireless communication of the data to the handheld computing (electronic) device 12 (figure 110 step 1064, column 60 lines 59-62, column 61 lines 18-24, and column 62 lines 7-15 and 43-47);

a display 1012 (graphical user interface) (figures 107-109) operably coupled to the audio kiosk 1000 (digital engine) to provide available information to a user of a communication network (e.g., the store) and to receive an input (e.g., artist, title, or category (figure 108)) from the user identifying a selected portion of the selectable information (figure 110 step 1060, column 61 lines 16-24, column 61 line 41 - column 62 line 15, and column 62 lines 28-33); and

wherein the display 1012 (interface) operates in a web browsing environment (e.g., when the audio files are stored in a remote server (column 61 lines 25-27) or when the user fills an order through the Internet 1022 (column 61 lines 34-36 and column 62 lines 19-27)) and the wireless communication operates outside the browsing environment (column 60 lines 57-62, column 61 lines 16-30, and column 62 lines 7-15 and 43-47).

Consider **claim 4**, and **as applied to claim 1 above**, Treyz et al. further disclose that the wireless communication comprises communicating through a remote wireless link (column 62 lines 7-15), wherein said remote wireless link is through a cellular communications network (column 13 lines 39-47).

Consider **claims 8-10**, and **as applied to claim 1 above**, Treyz et al. also disclose that the wireless communication comprises communicating via a local (short-range) RF (microwave)

wireless link such as Bluetooth link operating at 2.4 GHz (column 13 lines 22-38, column 60 lines 59-62, column 61 lines 18-24, and column 62 lines 10-15).

Consider **claims 16, 18, 23, and 31-39**, Treyz et al. clearly show and disclose a handheld computing (electronic) device 12 (wireless telephone) (figures 4-6 and 107-109 and column 9 line 57 - column 10 line 3) for communicating/receiving selected audio information (streaming audio information (e.g., when the user samples the audio) (column 60 lines 57-64, column 61 lines 25-30, and column 61 line 66 - column 62 line 4)) via wireless communication (figure 110 step 1064, column 60 lines 59-62, column 61 lines 18-24, and column 62 lines 7-15 and 43-47), the device 12 comprising:

wireless communications circuitry 96 (long-range communication module) (figure 4) operable to receive wireless communication of information (e.g., voice calls via a wireless (cellular) network) (column 15 lines 29-35);

a short-range RF communication module (either wireless communications circuitry 96 or 104 (e.g., Bluetooth operating at 2.4 GHz) (figure 4) operably coupled to a processor module 64 (figure 4, column 13 lines 23-38, and column 15 lines 3-7, 29-35 and 49-53);

a storage medium 72 (figure 4) operably coupled to the short-range RF communication module (either wireless communications circuitry 96 or 104) (figure 4), the storage medium 72 (figure 4) operable to store selected audio information that comprises an audio file (e.g., an MP3 file) (column 15 lines 8-10, column 60 lines 57-64, column 61 lines 25-30, column 61 line 66 - column 62 line 4, and column 62 lines 7-15);

the processor module 64 (figure 4) coupled to the storage medium 72, the processor

module 64 operable to process/play received selected audio information (column 62 lines 7-15); and

a display 80, 118 (figures 4 and 5) operable to display a web browser within a user interface (column 12 lines 28-37 and column 16 lines 15-22).

Consider **claim 19**, and **as applied to claim 16 above**, Treyz et al. also disclose that the short-range RF communication module (either wireless communications circuitry 96 or 104) (figure 4) outputs audio information indirectly to an audio speaker 114 (figure 4) (i.e., audio files are download and then played by the user) (column 60 lines 57-64 and column 62 lines 7-15).

Consider **claim 20**, and **as applied to claim 16 above**, since the handheld computing (electronic) device 12 of Treyz et al. can be an MP3 player (column 60 lines 62-64), it is clearly inherent that software for processing the selected information is included in the device 12.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. **Claims 5-7 and 21** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Treyz et al. (U.S. Patent # 6,587,835 B1)**, newly cited, in view of **well known prior art (MPEP 2144.03)**.

Consider **claims 5 and 7**, and **as applied to claim 4 above**, Treyz et al. clearly show and disclose the claimed invention except that the cellular communications network comprises a global system for mobile communications (GSM) network or a code division multiple access (CDMA) network.

However, the Examiner takes Official Notice of the fact that a cellular communications network comprising a GSM or a CDMA network is notoriously well known in the art.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time

the invention was made to slightly modify the system of Treyz et al. to include a GSM or a CDMA network as known in the art for purpose of serving a majority of users.

Consider **claim 6**, and **as applied to claim 5 above**, Treyz et al., as modified above, clearly show and disclose the claimed invention except that the GSM network operates between 1.7 GHz and 2.0 GHz.

However, the Examiner takes Official Notice of the fact a GSM network operating at PCS frequencies (i.e., 1.9 GHz) is notoriously well known in the art.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to further modify the system of Treyz et al. to operate the GSM network between 1.7 GHz and 2.0 GHz for purpose of serving PCS subscribers.

Consider **claim 21**, and **as applied to claim 16 above**, Treyz et al. clearly show and disclose the claimed invention except that the short-range RF communication module (either wireless communications circuitry 96 or 104) (figure 4) is operable to scan frequencies.

However, the Examiner takes Official Notice of the fact that short-range RF communication modules such as Bluetooth are well known in the art to operate by scanning frequencies for the purpose of locating an available frequency channel.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to slightly modify the device of Treyz et al. to allow the short-range RF communication module to scan frequencies for purpose of locating an available frequency channel.

11. **Claims 11, 13-15, and 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Treyz et al. (U.S. Patent # 6,587,835 B1)**, newly cited, in view of **Bottum (U.S. Patent # 6,014,569)**, of record.

Consider **claims 11, 13, and 30**, Treyz et al. clearly show and disclose a method for communicating selected information to a handheld computing (electronic) device 12 (figure 107), the method comprising:

maintaining data associated with the selected audio information using an audio kiosk 1000 (digital engine) (figure 107) (column 60 lines 57-62 and column 61 lines 25-30);

initiating wireless communication of the data to the handheld computing (electronic) device 12 (figure 110 step 1064, column 60 lines 59-62, column 61 lines 18-24, and column 62 lines 7-15 and 43-47);

presenting, in a web browsing environment (column 61 lines 25-27 and 34-36 and column 62 lines 19-27), information associated with audio information within a display 1012 (graphical user interface) (figures 107-109) associated a communication network (e.g., the store) (column 61 lines 16-24, column 61 line 41 - column 62 line 15, and column 62 lines 28-33); and

receiving an input (e.g., artist, title, or category (figure 108)) from a user identifying the selected information (figure 110 step 1060, column 61 lines 16-24, column 61 line 41 - column 62 line 15, and column 62 lines 28-33).

However, Treyz et al. do not specifically disclose the steps of receiving an input from a user identifying the handheld computing (electronic) device 12, the input including a reference identifying the handheld computing (electronic) device 12 and presenting in formation associated

with identifying handheld computing (electronic) device 12 (claim 13).

In the same field of endeavor, Bottum clearly shows and discloses a method for communicating selected audio information (abstract) comprising, among other steps, the step of receiving an input (ID data) from a user identifying a mobile interactive radio 150 (electronic device) (reads on presenting information associated with identifying the mobile interactive radio 150 (electronic device)), the input including a reference (ID of radio) identifying the mobile interactive radio 150 (electronic device) (figure 1, figure 3 step 330, column 3 lines 54-61, and column 5 lines 20-55).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the step of receiving an input from a user identifying the device taught by Bottum into the method of Treyz et al. for the purpose of enhancing the security by transmitting the audio information only to authorized subscribers (Bottum; column 2 lines 20-24).

Consider **claim 14**, and **as applied to claim 11 above**, Treyz et al., as modified by Bottum, further disclose wherein the display 1012 (interface) operates in a web browsing environment (e.g., when the audio files are stored in a remote server (column 61 lines 25-27) or when the user fills an order through the Internet 1022 (column 61 lines 34-36 and column 62 lines 19-27)) and the wireless communication operates outside the browsing environment (column 60 lines 57-62, column 61 lines 16-30, and column 62 lines 7-15 and 43-47).

Consider **claim 15**, and **as applied to claim 11 above**, Treyz et al., as modified by Bottum, also disclose that the wireless communication comprises communicating through a

remote wireless link (column 62 lines 7-15), wherein said remote wireless link is through a cellular communications network (column 13 lines 39-47).

Response to Arguments

12. Applicant's arguments with respect to **claims 1, 11, 16, and 34** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. Any response to this Office Action should be **faxed to** (703) 872-9306 **or mailed to**:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Crystal Park II
2021 Crystal Drive
Arlington, VA 22202
Sixth Floor (Receptionist)

14. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rafael Perez-Gutierrez whose telephone number is (703) 308-8996. The Examiner can normally be reached on Monday-Thursday from 6:30am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Marsha D. Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700 or call customer service at (703) 306-0377.

Rafael Perez-Gutierrez
R.P.G./rpg RAFAEL PEREZ-GUTIERREZ
PATENT EXAMINER

May 18, 2004

CHARLES APPIAH
PRIMARY EXAMINER